

Serial No.: 09/186, 247

1

REMARKS

2 These remarks follow the order of the paragraphs of the office action. Relevant portions of the
3 office action are shown indented and italicized.

4 said phenomenon comprising one of: a spectral analysis, a spectrum analysis, an image, an audio
5 clip, and a video clip.

6

DETAILED ACTION

7

Continued Examination Under 37 CFR 1.114

8 *1. A request for continued examination under 37 CFR 1.114, including the fee set forth in*
9 *37 CFR 117(e), was filed in this application after final rejection. Since this application is*
10 *eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR*
11 *1.17(e) has been timely paid, the finality of the previous Office action has been*
12 *withdrawn pursuant to 37 CFR 1.114. Applicants submission filed on 4/10/2006 has been*
13 *entered.*

14 *Based on the Applicant's amendment to the claims and persuasive arguments, the art*
15 *rejection is withdrawn. However there remain the issue of 35 USC §101 and 35 USC*
16 *§112. See the discussion below.*

17

Claim Rejections -35 USC § 101

18

19 *2. 35 U.S.C. 101 reads as follows:*

20 *Whoever invents or discovers any new and useful process, machine, manufacture, or*
21 *composition of matter, or any new and useful improvement thereof, may obtain a patent*
therefor, subject to the conditions and requirements of this title.

22 *3. Claims 1-11, 15-25, 46-49, 55-61, 65, 66 and 84-90 are directed to non-statutory subject*
23 *matter. Independent claims 1, 46, 48, 59, 65, 85 and 88-90 recite and show steps in the*
24 *body of claims for image signal transformation such inverse transformation. However 1,*
25 *46, 48 59, 65, 85 and 88-90 do not provide a practical application that produces a useful,*
26 *tangible and concrete result such as decompression or decoding of image signal. The*
27 *final result achieved by the claimed invention should be useful tangible and concrete. The*
28 *process claim must set forth a practical application of that judicial exception to produce*
29 *a real world result. Claims 2-11, 15-25, 47, 55-58, 60- 61, 66, 84-87 are dependent*
30 *claims therefore they are also rejected.*

31 In response, applicants respectfully state that all independent claims are amended to clearly state
32 that the effect is for one of: spectral analysis, spectrum analysis, image, audio clip, or video clip,

DOCKET NUMBER: YOR91998-0331US1**20/22**

Serial No.: 09/186, 247

1 for the phenomenon comprising one of: a spectral analysis, a spectrum analysis, an image, an
2 audio clip, and a video clip. Thus, claims 1, 46, 48 59, 65, 85 and 88-90 clearly provide a
3 practical application that produces a useful, tangible and concrete result for the phenomena. This
4 overcomes the rejections under 35 USC § 101 of claims 1, 46, 48 59, 65, 85 and 88-90, and also
5 of dependent Claims 2-11, 15-25, 47, 55-58, 60- 61, 66, 84-87. Thus all claims are statutory and
6 allowable.

7 ***Claim Rejections -35 USC § 112***

8 *4. The following is a quotation of the second paragraph of 35 U.S.C. 112: The*
9 *specification shall conclude with one or more claims particularly pointing out and*
10 *distinctly claiming the subject matter which the applicant regards as his invention.*

11 *5. Claims 1-11, 15-25, 46-49, 55-61, 65, 66 and 84-90 are rejected under 35 USC § 112 as*
12 *being indefinite.*

13 *Independent claims 1, 46, 48, 59, 65, 85 and 88-90 recite in lines 1-2 "digitally*
14 *processing integer transform data representing a phenomenon". In this limitation*
15 *phenomenon is vague and indefinite. Phenomenon is defined English dictionary as an*
16 *unusual, unaccountable or remarkable fact or occurrence. It is not clear from the*
17 *specification how phenomenon is digitally processed. Specification has discussed JPEG,*
18 *and video processing. Claims 2-11, 15-25, 47, 55-58, 60-61, 66, 84- 87 are dependent*
19 *claims therefore they are also rejected.*

20 In response, applicants respectfully state that all independent claims are amended to clearly state
21 that the phenomenon comprises one of: a spectral analysis, a spectrum analysis, an image, an
22 audio clip, and a video clip. Thus, with this limitation, the phenomena is clearly defined and is
23 not vague and indefinite. *This makes Claims 1-11, 15-25, 46-49, 55-61, 65, 66 and 84-90 clear*
24 *and definite. as being indefinite.* This overcomes the rejections under 35 USC § 112 of Claims
25 *1-11, 15-25, 46-49, 55-61, 65, 66 and 84-90,* and also of dependent Claims 2-11, 15-25, 47, 55-58,
26 60- 61, 66, 84-87. Thus all claims *particularly point out and distinctly claim the subject matter*
27 *which the applicant regards as his invention.* Thus all claims are allowable.

28 It is anticipated that this amendment shows that claims 1-90, except as withdrawn are allowable.
29 If any question remains, please contact the undersigned before issuing an office communication
30 with a FINAL status.

DOCKET NUMBER: YOR91998-0331US1

21/19

Serial No.: 09/186, 247

1 Please charge any fee necessary to enter this paper to deposit account 50-0510.

2 Respectfully submitted,

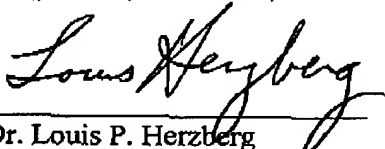
3 By: _____
4 Dr. Louis P. Herzberg
5 Reg. No. 41,500
6 Voice Tel. (845) 352-3194
7 Fax. (845) 352-3194
8 3 Cloverdale Lane
9 Monsey, NY 10952

10 Customer Number: 54856

11 It is anticipated that this amendment brings the application to allowance of all claims except as
12 withdrawn. Favorable action is respectfully solicited. If any rejections or objections remain,
13 please call the undersigned.

14 Please charge any fee necessary to enter this paper to deposit account 50-0510.

15 Respectfully submitted,

16 By: 
17 Dr. Louis P. Herzberg
18 Reg. No. 41, 500
19 Voice Tel. (845) 352-3194
20 Fax. (845) 352-3194
21 3 Cloverdale Lane
22 Monsey, NY 10952

23 Customer Number: 54856

DOCKET NUMBER: YOR91998-0331US1

22/22